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REMARKS

Claims 1-26 are pending. Claims 1, 2, 4 and 6 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,304,522 to Wuestman ("Wuestman"). Claims 1 and 6-8 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,237,883 to Lipic ("Lipic"). Claims 3, 5 and 9-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wuestman in combination with various secondary references.

Applicants have amended independent Claims 1, 13 and 20, as indicated above, to clarify Applicants' invention. Original Claims 2, 14 and 21 have been cancelled. Applicants respectfully traverse the rejections under 35 U.S.C. §102 and 35 U.S.C. §103 for at least the reasons set forth below.

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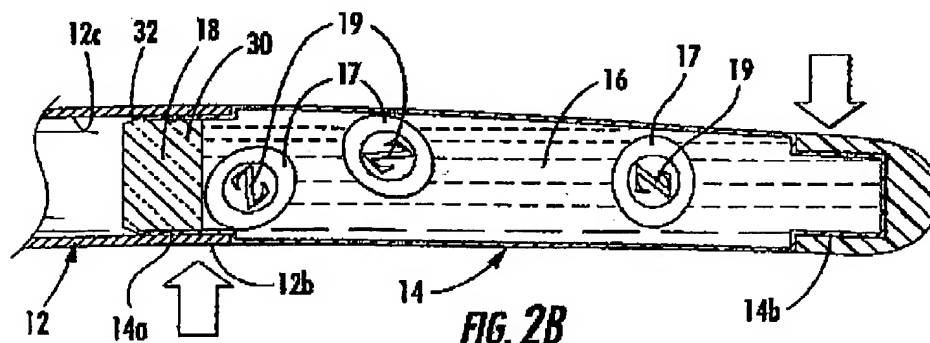
§102 Rejections Are Overcome

A claim is anticipated under 35 U.S.C. §102 if each claimed element is found in a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991); *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 138 (Fed. Cir. 1986). There must be no difference between the claimed invention and the reference disclosure, as viewed by an ordinary artisan. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d at 1576.

Applicants' amended independent Claim 1 recites a writing instrument, comprising:

an elongated first barrel portion that comprises an open first end through which a writing element is extendable, and an opposite open second end;
 a transparent, hollow second barrel portion that comprises an open third end and an opposite fourth end, wherein the third end is secured within the second end of the first barrel portion, and wherein the third end has an annular rim, an internal surface and an external surface;
 a fluid disposed within the hollow second barrel portion; and
 a plug disposed within the third end, wherein the plug prevents the fluid from escaping from the hollow second barrel portion, *wherein the plug comprises a shank and a head portion connected to the shank, wherein the head portion extends radially outward from the shank to define a circumferential shoulder, wherein the shank is disposed within the third end and the shoulder is in contacting relationship with the annular rim, and wherein the head portion tapers radially inward such that the head portion does not contact an inside surface of the first barrel portion second end and such that flexure of the first and second barrel portions relative to one another does not cause the head portion to contact the inside surface of the first barrel portion second end.*

Independent Claims 13 and 20 contain similar recitations. Fig. 2B from Applicants' application is set forth below:



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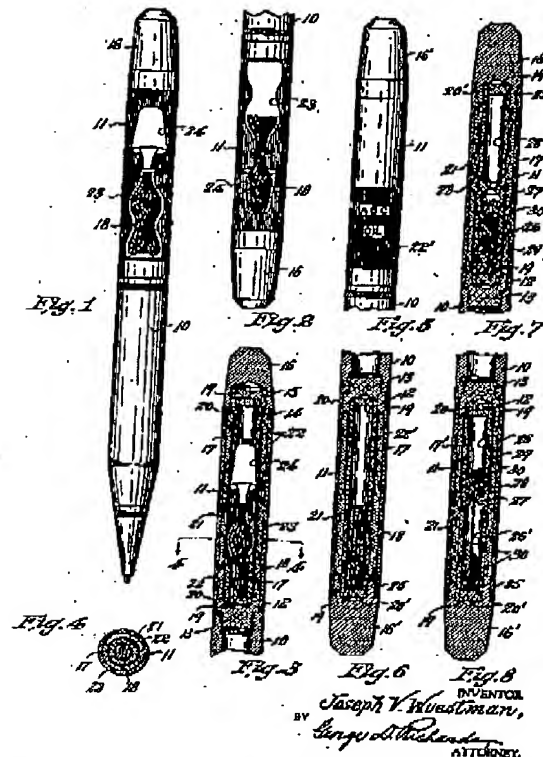
The open end 14a of the second barrel portion 14 has an annular rim 20, an internal surface 22 and an external surface 24, as illustrated. The plug 18 includes a shank 30 and a head portion 32 connected to the shank 30. The head portion 32 extends radially outward from the shank 30 to define a circumferential shoulder 34. When the shank 30 is disposed within the open end 14a, the shoulder 34 is in contacting relationship with the annular rim 20. The plug head portion 32 tapers radially inward such that the head portion 32 does not contact the inside surface 12c of the first barrel portion second end 12b and such that flexure or bending of the first and second barrel portions 12, 14 relative to one another does not cause the head portion 32 to contact the inside surface 12c of the first barrel portion second end 12b. The tapered configuration of the plug head portion 32 prevents contact with the inside surface 12c of the first barrel portion second end 12b even under extreme bending. By avoiding contact, the plug 18 remains undisturbed, thereby avoiding any loss of sealing ability.

The Action has taken the position that the writing instrument of Wuestman anticipates Claims 1, 2, 4 and 6 of the present application. In particular, the Action states that Wuestman discloses:

that the third end has an annular rim, an internal surface and an external surface (note Figs. 3 and 4) wherein the plug 12 comprises a shank (constituted by coupling element 13) and a head portion (constituted by the enlarged end at 12 (note Fig. 3)) connected to the shank 13, wherein the head portion extends radially outward from the shank (note Fig. 3) to define a circumferential shoulder (note Fig. 3), wherein the shank 13 is disposed within the third end and the shoulder is in contacting relationship with the annular rim (note Fig. 3), and wherein the head portion tapers radially inward (note Fig. 3) such that the head portion does not contact an inside surface of the first barrel portion 10 second end (note Fig. 3) and such that any degree of flexure of the first 10 and second 11 barrel portions relative to one another does not cause the head portion to contact the inside surface of the first barrel portion 10 second end especially since the screw threads would prevent this type of contact. (Action, Pages 2-3).

The figures from Wuestman are set forth below:

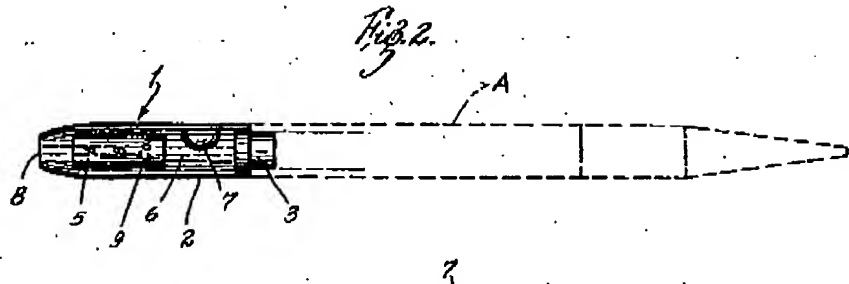
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As clearly illustrated in the figures and described in Wuestman, the plug 12 of the Wuestman writing instrument is *threadingly* engaged with barrel 10. Every portion of the plug 12, including the portions that the Action considers the head and shank, is in contact with the barrel 10. The Wuestman writing instrument fails to illustrate or describe a plug having a head portion that tapers radially inward as claimed in amended Claim 1 and as clearly illustrated in Applicants' Fig. 2B above. Moreover, Wuestman fails to teach that the head portion of plug 12 does not contact the inside surface of the barrel 10 under flexure as recited in Applicants' amended Claim 1. As viewed by the ordinary artisan, there is a great difference between Applicants' claimed invention and the writing instrument of Wuestman. Because Wuestman does not disclose all of the recited elements of independent Claim 1, Claim 1 and all claims depending therefrom are not anticipated by Wuestman.

The Action has also taken the position that Lipic anticipates Claims 1 and 6-8. The writing instrument described in Lipic is illustrated below:

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Clearly, the plug 3 of the Lipic writing instrument is in contact with the inner surface of the barrel. Lipic does not illustrate or describe a plug having a head portion that tapers radially inward as claimed in amended Claim 1 and as clearly illustrated in Applicants' Fig. 2B above. Moreover, Lipic fails to describe that a head portion of plug 3 does not contact the inside surface of the barrel 10 under flexure as recited in Applicants' amended Claim 1. As viewed by the ordinary artisan, there is a great difference between Applicants' claimed invention and the writing instrument of Lipic. Because Lipic does not disclose all of the recited elements of independent Claim 1, Claim 1 and all claims depending therefrom are not anticipated by Lipic.

In view of the above, the rejections under 35 U.S.C. §102 are overcome.

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§103 Rejections Are Overcome

A determination under §103 that an invention would have been obvious to someone of ordinary skill in the art is a conclusion of law based on fact. *Panduit Corp. v. Dennison Mfg. Co.* 810 F.2d 1593, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987), *cert. denied*, 107 S.Ct. 2187. After the involved facts are determined, the decision maker must then make the legal determination of whether the claimed invention as a whole would have been obvious to a person having ordinary skill in the art at the time the invention was unknown, and just before it was made. *Id.* at 1596. The United States Patent and Trademark Office (USPTO) has the initial burden under § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be **clear and particular**, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In an even more recent decision, the Court of Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be **particular** evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, as recently stated by the Federal Circuit with regard to the selection and combination of references:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining

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whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

In re Sang Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

For at least the same reasons set forth above with respect to 35 U.S.C. §102, Applicants respectfully assert that the primary reference, Wuestman, fails to teach or suggest the recitations of Applicants' independent claims, particularly as amended above, and all claims depending therefrom. Specifically, Wuestman fails to teach or suggest a writing instrument, comprising:

- an elongated first barrel portion...;
- a transparent, hollow second barrel portion that comprises an open third end... wherein the third end has an annular rim, an internal surface and an external surface;
- a fluid disposed within the hollow second barrel portion; and
- a plug disposed within the third end, ... wherein the plug comprises a shank and a head portion connected to the shank, wherein the head portion extends radially outward from the shank to define a circumferential shoulder, wherein the shank is disposed within the third end and the shoulder is in contacting relationship with the annular rim, and *wherein the head portion tapers radially inward such that the head portion does not contact an inside surface of the first barrel portion second end and such that flexure of the first and second barrel portions relative to one another does not cause the head portion to contact the inside surface of the first barrel portion second end.*

Moreover, neither the primary reference Wuestman, nor any of the secondary references recognize that flexure of a writing instrument containing a liquid and plug may be problematic from the standpoint that the plug may lose its seal and leak when contact is made with the inner surface of a barrel of the writing instrument. Not only do these references fail to appreciate the problem, they fail to teach or suggest Applicants' claimed plug structure in independent Claims 1, 13 and 20 that overcomes this problem. Accordingly, Applicants respectfully request withdrawal of the present rejections under 35 U.S.C. §103.

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In view of the above, it is respectfully submitted that this application is in condition for allowance, which action is respectfully requested.

Respectfully submitted,

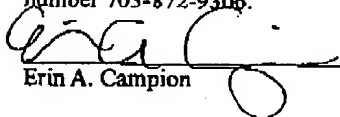


Needham J. Boddie, II
Attorney for Applicants
Registration No. 40,519

USPTO Customer No. 20792
Myers Bigel Sibley & Sajovec, P.A.
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401
Doc. No. 397642

CERTIFICATION OF FACSIMILE TRANSMISSION UNDER 37 CFR § 1.8

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Erin A. Campion